

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application of: AERTS, Eric.

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Art Unit:

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Examiner:

Morris, Terrell H.

For:

NOT-SEW SEAMLESS

**TECHNOLOGY** 

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#### APPEAL BRIEF UNDER 37 C.F.R. § 41.37

G22 Altesse Co. Ltd. 105 East 63rd Street New York, New York 10021 Appellant

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Mail Stop Appeal Brief-Patents Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

This is an appeal under 35 U.S.C. § 134 from a final rejection mailed December 13, 2006 of claims 1-7, 10-12, 14-31 and 33-47 and the restricting out of claims 48-73 by the Restriction Requirement imposed in the Office Action mailed September 9, 2003, as amended by the Office Action mailed November 4, 2004. The Notice of Appeal was filed on March 12, 2007. Appellant submits this original appeal brief accompanied by a Brief on Appeal Fee Transmittal Sheet (in duplicate).

#### I. REAL PARTY IN INTEREST

G-22 Altesse is the assignee of this application and the real party in interest.

#### II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any other pending appeals or interferences relating to the above-identified application.

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#### III. STATUS OF CLAIMS

Claims 1-7, 10-12, 14-31 and 33-47 have been finally rejected in the final Office Action mailed June 20, 2006, a rejection maintained by an Advisory Action mailed November 20, 2006. The restricting out of claims 48-73 was made Final in the Office Action mailed November 4, 2004. The rejections and the restriction requirement are being appealed.

The Final Restriction Requirement required elimination from examination of claims 48-73 out of the originally filed claims 1-73. Applicant elected with traverse Group II, which included claims 4, 7 and 26 that ultimately were dependent on claim 1, which itself was not included in Group II. Claims 48-73 were withdrawn and eventually cancelled.

As to additional amendments to the claims, the Response filed on July 21, 2004, in response to an Office Action mailed on January 23, 2004, amended claims 18-21 and 39-42. The Response filed on January 6, 2005, in response to an Office Action mailed on November 4, 2004, amended claims 1-2. This response also included a request for Continued Examination. Response filed September 26, 2005, in response to the Office Action mailed on March 29, 2005, amended claims 1, 8-9 and 12-13. Supplemental Response mailed on September 29, 2005 corrected a failure to include a copy of a decision cited in the September 26 Response without making any further amendments to the claims. Applicant filed Response with a Request for Continued Examination on March 30, 2006, in response to the Office Action mailed December 30, 2005, cancelling claims 8-9, 13, 32 and 48-73 and amending claims 1, 19 and 27.

Applicant amended claims 10 and 33 in the Response filed on September 22, 2006, in response to the Office Action mailed June 26, 2006 to correct the dependency of claims 10 and 33. Claims 1-7, 10-12, 14-31 and 33-47 were again rejected by Final Office Action mailed December 13, 2006. Applicant requested reconsideration of the rejections in the Response filed on February 8, 2007 requesting that the improper finality of the rejections be withdrawn. Claims 1-7, 10-12, 14-31 and 33-47 continued to be rejected by Advisory Office Action mailed March 7, 2007 leading to this appeal.

No amendments to the claims have been proposed or made following the issuance of the Office Action mailed December 13, 2006. A listing of the appealed claims is presented in Exhibit B (Claims Appendix.

#### IV. STATUS OF AMENDMENTS

Appellant filed no claim amendments after the December 13, 2006 mailing date of the Final Office Action, although a response was filed without amendments to the claims on February 8, 2007.

The following amendments have been entered: Preliminary Amendment filed on October 16, 2002 for amending the specification to perfect a priority claim. Preliminary Amendment filed on March 14, 2003 for amending the specification to further perfect priority claims to co-pending patent applications. Response to Restriction Requirement filed on October 9, 2003 electing claims in Group II. Amendments to claims 18-21 and 39-42 filed on July 21, 2004. Amendments to claims 1-2 filed on January 6, 2005 Amendments to claims 1, 8-9 and 12-13. Amendment filed March 30, 2006 cancelling claims 8-9, 13, 32 and 48-73 and amending claims 1 and 19 and 27. Amendments to claims 10, 27-29 and 33 filed on September 22, 2006 correcting the dependency of claims 10 and 33 and adding the term 'fabric' to claims 27-29.

No amendments to the claims have been proposed or made following the issuance of the Office Action mailed December 13, 2006. A listing of the appealed rejected and restricted out claims is presented in Exhibit B (Claims Appendix), of which the restricted out claims had to be cancelled as described above.

#### V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The appealed claims and decisions relate to a laminated garment, such as a brassier, and methods for making such garments using one or more of (i) prelamination procedure for handling the adhesive; and (ii) thin films of ester-based polyurethane adhesive.

Prelamination is tacking on of an adhesive layer by application of pressure and temperature less than that required for lamination. This makes it possible to readily handle and manipulate fabric and inserts prelaminated with a rather thin layer of an adhesive before complete lamination is carried out.

Applicant discovered that the texture and finish of laminated garments could be improved by better handling of the adhesive film, which tends to be tacky and fragile, to allow a relatively uniform application of thin layers of difficult to use adhesives such as ether-based polyurethane or hydrolytically stabilized ester-based polyurethane.

Prelamination is suitable for making laminated garments that are comfortable to wear and have edges resistant to fraying or splaying while being suitable for procedures like molding.

With the use of prelamination, molding procedures can be undertaken for shaping the laminate such as in making cups in brassieres. Further, pre-lamination helps make finished garments that are not unwieldy while having sufficient strength and durability along with favorable breathing properties desired for routine use. Further, various inserts, like pads and wires, readily incorporated into the garment. The superior edge finish allows elimination or reduction of the ungainly appearance of seams.

The originally filed claims described the use of prelamination and adhesive films for making laminated garments with dependent claims providing description of the favorable aspects of such garments.

Claims 1 and 27 find support in the published application, for instance for terms common to both independent claim: with prelamination described in paragraphs 40 and 46; an adhesive layer 915 is shown being prelaminated onto fabric 920 in Figure 9, two fabric layers, with one being prelaminated are placed together in accordance with paragraph 43 and Figure 6 (prelaminated fabric layer 600 has a film of adhesive on it such that it is sandwiched between the second fabric layer 610). The thickness of the adhesive layer is described, for instance, in original claims 10 through 12. The lamination as applied to make a brassier (claim 27) is described in paragraphs 57 through 59 and Figure 13 shows a setup for molding a cup in a brassier. A finished brassier made by the lamination procedure is shown schematically in Figure 14 and described in paragraph 53 (including a description of unsewn edges).

Further detailed description of disclosed embodiments are presented in the specification at paragraphs 16-67 of the published application and the accompanying Figures.

#### VI. GROUNDS TO BE REVIEWED ON APPEAL

The following decisions are presented for review in this appeal:

- (A) Whether restricting out a single claim into Group III is proper.
- (B) Whether restricting out method claims into Groups IV and V is proper in view of the expected searches and the actual searches undertaken.
- (C) Whether ignoring a reference pointedly teaching away from from claim 1 is proper for rejecting claims 1, 27 and claims ultimately dependent on them.

#### VII. ARGUMENT

The restriction requirements and rejections made in this case reflect fundamentally flawed presumptions that conflict with the law, regulations and common experience. The Restriction Requirement are based on unsupported presumptions and assertions that conflict with the evidence available in the record. The rejections require selective reading of the prior art by ignoring references that each away from the claims. These shortcomings are further discussed below to support the request to withdraw the Restriction Requirement and allow the rejected claims.

#### A. Applicable Case Law, Regulations and Guidelines

#### A.1. IMPOSITION OF A RESTRICTION REQUIREMENT

More than one invention may not be claimed in one national application. 37 C.F.R. 1.141. Authority for this prohibition is statutory in that restriction may be required if there are two or more "independent and distinct" inventions in a patent application. 35 U.S.C. 121.

MPEP § 802.01 (I) clarifies independent inventions have "no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operations, or effect . . . ." Examples of independent inventions include species (of a genus) that are *not usable together* as defined or process and apparatus *incapable* of beign used in practicing the process. *Id* (emphasis added).

MPEP § 802.01 (II) goes not to clarify the distinct inventions "as claimed are nto connected in at least one of design, operation, or effect and . . . at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER . . . . ." Emphasis in original.

Further, even if two or more inventions are presented, if a search and examination of an entire application can be made without serious burden, the examiner must examine the application on the merits even if the application includes claims to independent or distinct inventions. See, e.g., MPEP § 803.

#### A.2. OBVIOUSNESS

A finding of obviousness under 35 U.S.C. §103 requires a determination of: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the difference between the claimed subject matter and the prior art; and (4) whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. Deere* 383 U.S. 1 (1966). Whether the differences make the subject matter obvious to one of ordinary skill in the art at the time the invention was made is evaluated with the aid of many factors while guarding against decision making improperly based on hindsight. *Id.* at 36.

The Federal Circuit has articulated a subsidiary requirement for the first Graham factor, the scope and content of the prior art. *SIBIA Neurosciences, Inc. v. Cadus Pharma*. *Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000). The scope and content of prior art is evaluated to determine if it directly or indirectly contains a teaching, suggestion, or motivation to combine multiple references in a manner that renders the invention obvious. The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

The need and utility of guarding against improper hindsight has been reiterated by the Supreme Court in KSR International CO. v. Teleflex Inc. et al., at 17 Slip Opinion, cautioning against "ex post reasoning." KSR further clarifies that "if a person of ordinary skill can implement a predicable variation, §103 likely bars its patentability." Id. at 13. KSR pointedly noted the absence of "anything in the prior art that taught away" in upholding the finding of obviousness by the trial court below. Id. at 22. Further, "obvious to try" inquiry was also favorably remarked upon in KSR in providing guidance for evaluating whether a claim is obvious. Id. at 17.

As to the scope and content of the prior art, patentable apparatus claims must be structurally distinguishable from the prior art. See, e.g., MPEP § 2114. Further, even if the claimed subject matter is not literally disclosed by a reference, it may be inherent. See, e.g., MPEP § 2112. Something that is old does not become patentable upon the discovery of a new property. See, e.g., MPEP § 2112 (I). However, the Examiner must show rationale or evidence tending to show inherency. Id.

The difference between the claimed subject matter and the prior art requires claim interpretation. See, e.g., MPEP § 2141.02 directing to MPEP §§ 2111-2116. The Patent Office is to give claims their broadest reasonable interpretation. See, e.g., MPEP § 2111 citing to recognition of this practice by the Federal Circuit in Phillips v. AWH Corp., 415 F.3d 1303, 1310 (Fed. Cir. 2005 en banc). Words in the claims must be given their plain meaning unless defined otherwise in the specification. See, e.g., MPEP § 2111.01. 'Plain Meaning' refers to the ordinary and customary meaning given to the terms by those of ordinary skill in the art. See, e.g., MPEP § 2111.01 (III).

The burden shifts to the applicant once a reference teaching a product appearing to be substantially identical (to the claimed invention) is made the basis of a rejection coupled with evidence or reasoning tending to show the substantial identity.

Many factors may be considered to evaluate if the invention is not obvious in view of the differences between the prior art and the claimed invention. A known but unsolved problem or solutions that teach away from the invention are examples of factors that tend to show the invention is not obvious. In evaluating the differences between the prior art and the claimed invention, the relevant inquiry is: (1) whether the prior art suggests the invention; and (2) whether the prior art provides one of ordinary skill in the art with a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

When selective combination of prior art references is required to render obvious a subsequent invention, "there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F2d. 931, 934 (Fed. Cir. 1990) "[T]here must be some reason for the combination other than the hindsight gleaned from the invention itself. There must be 'something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). This inquiry is part of identifying the scope and content of the prior art. The Federal Circuit has repeatedly clarified that the test is a flexible one which may find motivation to combine in the knowledge of one skilled in the art or in the nature of the problem to be solved. *Alza Corp. v. Mylan Labs.*, *Inc.*, 464 F.3d 1286, 1291 (Fed. Cir. 2006).

The case law has been especially vigorous on guarding against using "hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the

claimed invention." See, e.g., In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Federal Circuit said in In re Dembiczak

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. ... Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 175 F.3d 999 (emphasis added). With respect to what might meet the requirement of a showing of motivation, the Federal Circuit said that

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). The Examiner must "explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). With respect to the sources where motivation to combine may be found, the Federal Circuit stated that "[t]his court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

The case law further requires that each reference must be evaluated as a whole, *i.e.*, disclosures in the reference that diverge from and teach away from the invention cannot be disregarded. "Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985). "It is impermissible within the framework of a Section 103 rejection to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what the reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 241 (C.C.P.A. 1965) (emphasis added).

#### B. Restricting A Single Claim 48 Into Group III Must Be Reversed

The five-way Restriction Requirement is inconsistent and arbitrary. The Restriction Requirement identified five distinct patentable inventions— Group I: claims 1-3, 5-6, 8-25; Group II: claims 4, 7, 26-47, Group III: claim 48; Group IV: 49-62; and Group V: claims 63-73. Applicant elected claims 4, 7, 26-47 placed in Group II.

#### **B.1.** RESTRICTION REQUIREMENT IS INCONSISTENT

The Examiner called petitioner's representatives, Rattan Nath of Pennie & Edmonds LLP, on August 8, 2003 to communicate a *two-way restriction* between claims 1-48 and claims 49-73. In response to the request for an election, Mr. Rattan Nath requested more time. This resulted in the issuance of a *five-way* Restriction Requirement mailed on September 9, 2003, instead of the expected *two-way* Restriction Requirement communicated on August 8.

Applicant elected with traverse Group II, which included claims 4, 7 and 26 that ultimately were dependent on claim 1. Claim 1 was not included in Group II. The five-way Restriction Requirement was made Final in the very next Office Action mailed on January 28, 2004. Notwithstanding the finality of the Restriction Requirement, the claims in Group I were rejoined with Group II by the Office Action mailed on November 4, 2004 resulting in the examination of claims 1-47.

The five-way Restriction Requirement as imposed was unworkable as originally imposed. That the Restriction Requirement mailed on September 9, 2003 was unworkable was apparently understood by the Examiner. Upon the election of Group II by the Applicant, which group comprised dependent claims while leaving out the underlying independent claim, the Examiner marked unelected independent claim 1, originally included only in Group I, as an elected claim. See, e.g., Exhibit C, which shows a paper dated January 20, 2004 with claim 1 marked as elected. The Examiner did not communicate the decision to examine claim 1 to the Applicant in the Office Action mailed on January 28, 2004. Instead the Examiner made the September 9 Restriction Requirement Final arguing that examining additional claims was too burdensome as indicated in the Office Action mailed on January 28, 2004. See, e.g., page 2 of the Office Action. Exhibit C demonstrates the alleged burden was not really there because at least independent claim 1 in Group I was already marked for examination.

## B.2. RESTRICTION REQUIREMENT JUSTIFICATION CONFLICTS WITH ACTUAL SEARCHES

Subsequently, all of the claims of Group I were rejoined for examination by the Office Action mailed on November 4, 2004, presumably in view of this demonstrable unworkability, while maintaining the remainder of the Restriction Requirement as Final.

Restricting out Group III, which has only claim 48 is justified on the basis that examining claim 48 is also allegedly *too burdensome*. Claim 48 is addressed to a brassier having two cups with an insert while Group II claims are addressed to a laminate garment with at least one cup. This additional burden of searching and examination based on this distinction is difficult to understand if the policy in MPEP § 803 has any meaning. Furthermore, art relating to an insert made integral with a brassier, the subject matter of Group III, was cited from the very first Office Action on the merits mailed on January 28, 2004 for rejecting claims. *See*, *e.g.*, pages 3-4 of the Office Action. This art continues to be the basis of many of the appealed rejections.

Further, the actual searches undertaken are disclosed by the record to not be restricted to the Groups and classes cited as the basis for the Final Restriction Requirement as is discussed below.

Therefore, the Restriction of claim 48 into Group III must be withdrawn because it is inconsistent with the policy and directives provided by the MPEP. See, e.g., MPEP § 803.

#### C. Restricting Claims 49-73 Into Groups III And IV Must be Reversed

Groups IV and V contain claims 49-73 directed to making laminated items using the prelamination technique for handling thin sheets of polyurethane adhesive. Prelamination is tacking on of an adhesive layer by application of pressure and temperature less than that required for lamination. This makes it possible to readily handle and manipulate fabric and inserts prelaminated with a rather thin layer of an adhesive before complete lamination is carried out.

All of the claims as originally examined had an express limitation reciting the use of prelamination for making the claimed laminated articles. The record demonstrates that lamination techniques have already been searched, presumably in view of this limitation. See, e.g., Exhibit D recording searches for "laminate' and 'bubble near2 molding'" as well as a separate search for "laminate and fabric and (adhesive near3 film near3 layer) and mold\$3)". It is presumed that none of the references so identified were better suited than the references relied upon for maintaining the rejections being appealed herein.

Subsequently, because the Examiner argued that this limitation was not being examined, claims were amended to move the prelamination limitation into the preamble in view of the fact that the remaining subject matter continuted to be patentable. It is believed that presently the preamble is not a limitation on the scope of the pending claims appealed herein. Notwithstanding the amendments to the preamble, it is believed that the assertion that the restricted out method claims 49-73 present *too much of a burden* is not supported by the record because such searches have already been undertaken. Searching additional classes is also not a burden because searches in additional classes have already been undertaken. See, e.g., the last sheet in Exhibit D, shows that classes, such as class 2, which is not recited in the Restriction Requirement has been searched. Therefore, the Restriction of Group IV and V should be reversed because the alleged burden of examining is not credible.

#### D. <u>Combination Of The Smith And Battreal References Does Not Disclose Or</u> Suggest The Use Of Less Than 5 Mils Thick Polyurethane Adhesive Layers

Claims 1-7, 10-12, 27 and 33-34 have been rejected as obvious under 35 U.S.C. § 103(a) over US Patent No. 5,447,462 (the "Smith patent") in view of US Patent No. 5,234,523 (the "Battreall Patent") have been rejected under 35 U.S.C. § 103(a) by the Final Office Action mailed on December 13, 2006 and the Advisory Action mailed on March 7, 2007. All of the rejected claims have in common a limitation calling for the use of an adhesive film of ester-type polyurethane that is less than four (4) mils thick while being more than about 0.5 mils.

#### D.1. THE SMITH REFERENCE

The Smith reference pertains to making brassieres and other laminated garments. The Smith Reference, however, does not discuss polyurethane as an adhesive, a fact that is admitted in the basis offered for rejecting all of the pending claims.

#### D.2. THE BATTREAL REFERENCE

The Battreal Reference also relates to laminates. However, contrary to the assertions repeatedly made in the various rejections, Battreal does not show or even attempt to show that a polyurethane-adhesive is an equivalent of polyamides-based adhesives. It is silent on any such comparison.

## D.3. CITING THE RUDY REFERENCE DOES NOT OPERATE TO AVOID THE TEACHING AWAY BY THE HAIGH REFERENCE

The Rudy Reference (US Patent No. 5,042,176) does not discuss polyurethane as an adhesive or clearly relate to laminated garments. It is not clear why this reference is relied

upon for making the rejections because the Rudy reference does not address making laminates or choosing adhesives. Rudy is strangley enough cited by the Final Office Action mailed on December 13, 2006 on page 5 in a description of inflated elastomeric devices in footwear. No explanation is offered for linking footwear devices to laminated fabrics and in particular to thin lamination adhesives. The lesson one of ordinary skill in the art is presumed to derive from the inflatable devices in footwear leading to renewed vigor in routine experimentation to overcome the preferred limits disclosed of Haigh is also left to wild speculation.

The citation of the Rudy Reference is even more confusing in view of the fact that previously US Patent No. 5,447,462 ("Haigh") was cited and is in the record. Haigh teaches lamination and discusses polyurethane adhesives. Haigh, however, teaches away from the claimed invention because it recommends that thickness of the adhesive layer be more than five (5) mils and preferably about ten (10) mils. However, this disclosure of Haigh does not make it less suitable for identifying patentable subject matter. Therefore, the required prima facie case cannot be made by citing the Rudy Reference and merely ignoring the Haigh Reference. Equity requires that Haigh's disclosure be taken into account instead of exclusive reliance on improper hindsight and fanciful speculation.

## D.4. REJECTIONS OF INDEPENDENT CLAIMS 1 AND 27 MUST BE REVERSED

Claim 1 includes the limitation "a heat sensitive adhesive layer comprising polyurethane with a thickness of more than about 0.5 mils and less than about four (4) mils." Similarly, independent claim 27 includes the limitation "wherein the adhesive layer is more than about 0.5 mils and less than about 4 mils."

The Office Actions have maintained the rejections of all pending claims without providing the detailed basis necessitated by the record.

#### **D.4.a** Thin adhesive layers make better laminated garments

First the Rejections maintain that a thin adhesive layer confers no advantage—without providing any evidence to support this dubious assertion. While a resort to common knowledge may be used to ordinarily dispel this misconception, even an affidavit from the inventor was not sufficient in this case to establish this self evident advantage. It is noteworthy that the MPEP requires that presumptions without backing with evidence have to be so correct as to be susceptible to easy confirmation if challenged.

**D.4.b** Faced with known difficulty in using thinner adhesives, routine experimentation cannot be presumed to discover the subject matter of claims 1 and 27

Second, the Rejections assert 'routine experimentation' would be sufficient to reveal the claimed invention. However, a reference describing such routine experimentation and coming to a different conclusion has been ignored in favor of less specific references. This improper hindsight based reasoning that is further weakened by its reliance on presumptions inconsistent with the record is improper and conflicts with both the policy for examining patent applications and the teachings of the Supreme Court.

#### **D.4.c** The grounds for sustaining the rejections are inconsistent

Third, the grounds for maintaining the rejections are internally inconsistent. On one hand, the rejections maintain that a person with ordinary skill in the art would by routine experimentation will experiment with adhesive layers that are less than 5 mils thick. On the other hand, the appealed rejections ignore such experimental results because they do not square with the erroneous presumptions underlying the rejections. All of this without presenting a better or more reliable reference to substantiate why should a person having ordinary skill in the art develop the use of thinner adhesive layers when such thin layers are being presumed to confer no advantage in yet another inconsistent basis offered to support the rejections.

The argument for making the rejections is fundamentally flawed. The argument is premised on ignoring the Haigh reference in the record and instead conclusively presuming that 'routine' experimentation will reveal the claimed invention—notwithstanding the teaching away by prior art. Requests by applicant for substantiating this presumption have failed to elicit a factual or other basis.

Therefore, the rejections based on the assumption that prior art discloses an adhesive thickness of less than 5 mils because it would be discovered through 'routine' experimentation should be reversed. The scope and content of the prior art lack the limitations in the absence of presuming the same based on impermissibly exclusive reliance on hindsight.

The independent claims 1 and 27 are patentable at least because the difference between the prior art and the claimed invention would not have been obvious to one having ordinary skill in the art in view of the record.

#### **D.4.d** The scope and content of the prior art

The scope or content of the prior art comprises (1) the Smith Reference disclosing the use of amide based adhesive layers; (2) the Battreal Reference disclosing the use of adhesive comprising polyurethane without any discussion of or the desirablility of using such adhesives; (3) the Haigh Reference disclosing that Polyurethane films of less than 5 mils are not suitable for making laminated articles.

Other prior art references, such as Kollmanthaler, Tedeschi and Rudi do not provide sufficient additional details to overcome the shortcomings or teaching away of the Smith, Battreal and Rudy references at least for examining independent claim 1.

Therefore, the prior art does not include (3) a teaching, suggestion or motivation to combine the Smith Reference with the Battreal Reference because the combination does not, even in hindsight, meet all of the limitations of the claimed invention. As taught in the relevant case law, see, e.g., SIBIA Neurosciences at 1356, the prior art should include a basis for combining the references, for instance in the form of a teaching, suggestion or motivation to make the combination. In this case, combining the Smith Reference with the Battreal Reference requires an additional presumption that is counter to the disclosure of the Haigh Reference, which presumption is therefore improper.

The prior art also does not include (4) any teaching of a prelamination procedure for handling thin films of adhesives.

#### **D.4.e** Difference between the prior art and the claimed invention

The record reveals that the difference between the prior art and the claimed invention includes at least the use of an adhesive film of ester-type polyurethane that is less than four (4) mils thick while being more than about 0.5 mils thick.

In addition, the prior art does not include the prelamination procedure for handling thin adhesive films, although this aspect of the claim goes to enablement rather than defining the metes and bounds of claim 1 because it is recited in the preamble.

The Advisory Action and the Final Office Action make light of the shortcomings of the prior art by assuming that all the differences are discoverable by routine experimentation. The argument made by the Office Action is specious at best because not only the prior art does not disclose the general conditions of claim 1, it discloses a different optimal range, as disclosed by the Haigh Reference without contradiction elsewhere.

This assumption is not backed by evidence in the form of the Haigh Reference. There is no rationale or evidence showing inherency as is required by MPEP § 2112 (I). The words

in the claims have yet to be interpreted in accordance with MPEP § 2112 (I) to shed light on any unusually broad meaning being assigned to the pending claims. While reliance on hindsight is freely used by the Office Actions and Advisory Actions, it is justified by the assertion that discovering optimal ranges is not inventive if general conditions of the claim are disclosed in the prior art. *See*, *e.g.*, page 4 of the Final Office Action mailed on December 13, 2006 at the end of the first paragraph.

#### **D.4.f** Level of skill in the art

The standard of a person having ordinary skill in the art is satisfied by a person knowledgeable about lamination, who takes into account the teachings provided by experts and other patents, rather than ignore and discount their teachings and suggestions.

#### **D.4.g** Reasoning and evidence offered to support the Rejections

The reasoning for the rejections includes the three part argument that: (1) general conditions of claim 1 are disclosed in the prior art (without explaining how are these conditions actually discloses in the cited references that are mostly silent on the type of adhesive or the form of the adhesive recited in claim 1; and (2) that discovering optimal conditions is consequently not inventive or patentable; and (3) the conclusory assumption that contrary prior art disclosures are irrelevant.

Plainly, Smith and Battreal References do not disclose or suggest the subject matter of claims 1 or 27 contrary to the unsubstantiated fanciful assertion in the Final Rejection mailed December 13, 2006 (on page 5).

The Smith Reference deals with making laminates using amide based adhesives with the focus on providing differential elongation, *i.e.*, more flexibility in one direction than in another. It teaches using a web of a polyamide material as and adhesive to accomplish this property.

The Battreal Reference discloses possible use of polyurethane in passing for making laminates using superheated steam to provide laminate a gas permeable layer onto a substrate. Battreal teaches use of a layer of water on the gas permeable layer that turns into steam upon application of a superheated platen, which steam also provides the heat and pressure for completing the lamination process by melting the adhesive sandwiched between the gas permeable layer and the substrate. Battreal does not disclose any conditions for using polyurethane adhesives.

## **D.4.h** Lack of a reasonable likelihood of success for the combined references

Combining the Smith Reference with the Battreal Reference does not lead to either the desirable thickness of the adhesive or a reason for using polyurethane based adhesives and the form in which they should be used to make the most desirable articles. All of these details have to be assumed to be the same as in claim 1 for rejecting claim 1 based on the Smith Reference combined with the Battreal Reference. Further, one of ordinary skill in the art would need to completely ignore the more directed teachings of the Haigh Reference in order to engage in additional experimentation.

**D.4.i** The difference of the claimed subject matter from the prior art is not obvious because the prior art teaches away from it

The rejections are premised on the erroneous conclusory presumption that the claims are obvious, rather than making an actual demonstration of obviousness. This presumption is not a sufficient basis because it does not satisfy the requirement of (1) the all elements rule requiring that all elements of a claim be found in the prior art, and (2) the guard against improper reliance on hindsight requiring showing of a teaching, suggestion, or motivation to make the combination.

Presuming the result, as in the proceedings below, subverts the requirement for presenting an argument, evidence or reasons for arriving at the result by deductive reasoning. Indeed, the presence of prior art in the form of the Haigh Reference that teaches away precludes such generous unsupported presumptions. Indeed, the presumed details of claim 1 are not insignificant details because no recourse other than assuming them to be satisfied was possible for maintaining the rejections.

Appellant pointed out in the proceedings below that there is no basis for ignoring the Haigh Reference, but to no avail. Therefore, the proceedings below ignore both the problem addressed by this application and its claimed solution. Instead, the Final Rejection and the Advisory Action insist on assuming the solution. What is missing in the rejections is any discussion that is not based on the Appellant's own disclosure. Further, although case law requires that each reference be evaluated as a whole for what it discloses, see, e.g., Interconnect Planning, the conclusory rejections also ignore this guideline.

The Supreme Court has provided additional guidance in that references that teach away from the claims are an important factor in deducing whether the claims are non-obvious. See, e.g., the focus of the Court in finding the absence of "anything in the prior art that taught away" in upholding the finding of obviousness by the trial court below. KSR. at 22.

Therefore, such references, in this case the Haigh Reference, cannot be ignored without providing a proper reason.

In view of the above, it is plain that one of ordinary skill in the art would not interpret the Haigh Reference to be mere dicta and the passing reference in Battreal, alone or in combination with Smith, to be a general disclosure of claims 1 and 27.

In summary, the claimed invention is not obvious because first, the prior art does not disclose all of the limitations of the claimed invention; second, the suggested combination of references necessarily assumes too much; and third, the prior art fails to provide a teaching, suggestion or motivation, based on the nature of the problem or knowledge of one having ordinary skill in the art, to combine the cited references in the manner suggested by the rejections.

D.4.j The Rejection Under 35 U.S.C. § 103(a) Of Claims 1-7, 10-12, 27 And 33-34 As Obvious Over US Patent No. 5,447,462 In View Of US Patent No. 5,234,523 Should Be Reversed

Claims 1-7, 10-12, 27 and 33-34 have been rejected under 35 U.S.C. § 103(a) over US Patent No. 5,447,462 ("Smith") in view of US Patent No. 5,234,523 ("Battreal"). The rejections are difficult to understand because neither relied on reference relates to adhesives comprising polyurethane with the thickness limitations recited in the rejected claims starting with the independent claims 1 and 27, on which the remaining claims are ultimately dependent.

In view of the inferences based on improper hindsight as described earlier, an error compounded by ignoring unfavorable art and relying exclusively on presumptions, it is respectfully requested that the rejections be set aside.

**D.4.k** The Rejection Under 35 U.S.C. § 103(a) Of Claims 14-24 and 35-45 As Obvious Should Be Reversed

Claims 14-24 and 35-45 have been rejected under 35 U.S.C. § 103(a) over Smith in view of Battreal further in view of US Patent No. 5,042,176 ("Rudy").

In view of the inferences based on improper hindsight as described above, the unsuitability of the combination of Smith and Battreal is not cured by Rudy, an error compounded by ignoring unfavorable art. Therefore, it is respectfully requested that the rejections of claims 14-24 and 35-45 be set aside.

**D.4.1** The Rejection Under 35 U.S.C. § 103(a) Of Claims 1-7, 10-12, 27 And 33-34 As Obvious Should Be Reversed

Claims 25 and 26 have been rejected under 35 U.S.C. § 103(a) over US Patent No. Smith in view of Battreal further in view of US Patent No. 5,967,876 ("Kollmanthaler").

In view of the inferences based on improper hindsight as described above, the unsuitability of the combination of Smith and Battreal is not cured by Kollmanthaler, an error compounded by ignoring unfavorable art, it is respectfully requested that the rejections of claims 25 and 26 be set aside.

**D.4.m** The Rejection Under 35 U.S.C. § 103(a) Of Claims 1-7, 10-12, 27 And 33-34 As Obvious Should Be Reversed

Claims 28-31 and 41 have been rejected under 35 U.S.C. § 103(a) over US Patent No. Smith in view of Battreal further in view of US Patent No. 5,984,762 ("Tedeschi").

In view of the inferences based on improper hindsight as described above, the unsuitability of the combination of Smith and Battreal is not cured by Tedeschi, an error compounded by ignoring unfavorable art, it is respectfully requested that the rejections of claims 28-31 and 41 be set aside.

#### VIII. CLAIMS APPENDIX

As noted in Section III above, an appendix containing a copy of the claims involved in this appeal is submitted herewith as Exhibit B.

#### IX. EVIDENCE APPENDIX

Exhibit C has a record from the file history of this application showing the claims marked for examination following the election made in response to the Restriction Requirement.

Exhibit D presents records from the file history noting some details of searches made in the course of examining this application.

Exhibit E includes an affidavit by the inventor in a futile effort (so far) to clarify the nature of the invention submitted pursuant to 37 C.F.R. § 1.132.

#### X. RELATED PROCEEDINGS APPENDIX

As noted in Section II above, Appellant is not aware of any proceeding or interference which may be related to, directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

#### XI. <u>CONCLUSION</u>

Appellant respectfully submits that the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over the Smith Reference in view of the Battreal Reference is improper and should be withdrawn. Further, remaining claims are allowable axiomatically in view of their dependence on patentable claim 1.

Appellant also submits that the Restriction Requirement imposed in this case should be withdrawn to permit examination of all of the claims in view of the evidence that (i) no undue burden is imposed by such an examination, and (ii) the Office Actions have misrepresented the burden imposed by examining all of the claims while making the Restriction Requirement final.

Therefore, for all of the reasons set forth above, Appellant respectfully requests that all of the claims on appeal be declared allowable. The filing of the Brief on Appeal is timely today being within two months of filing of the Notice of Appeal.

A fee of \$250 is estimated to be due with this filing of the Appeal on Brief under 37 C.F.R. 40.20(b)(2). This fee is enclosed. A copy of this page is enclosed for fee payment purpose.

Respectfully submitted,

Date: May , 2007

Dieter Kemp

For

For Assignee of all rights

G22 Altesse Co. Ltd.

105 East 63<sup>rd</sup> Street

New York, New York 10021

## EXHIBIT A REAL PARTY IN INTEREST

#### <u>U.S. APPLICATION NO. 10/001,286</u> <u>ATTORNEY DOCKET NO. 9971-005-999</u>

I. Assignment from Eric Aerts to G22 Altesse Co. Ltd. executed on November 30, 2001 recorded on August 16, 2001 at Reel # 012349 at Frame# 0222.

NYI-3977916v1 -20-

#### EXHIBIT B CLAIMS APPENDIX

## CLAIMS ON APPEAL U.S. APPLICATION NO. 10/001,286 ATTORNEY DOCKET NO. 9971-005-999

1. A fabric laminate with an adhesive layer pre-laminated on a first fabric as a film tacked on the first fabric by application of pressure and temperature less than that required for lamination followed by placement of the adhesive layer between opposed surfaces of the first and a second fabric for adhesively securing said first and second fabrics together along their opposed surfaces in a lamination step by positioning the second fabric on the pre-laminated first fabric and applying sufficient pressure and temperature comprising:

the first fabric,

the second fabric and

a heat sensitive adhesive layer comprising polyurethane with a thickness of more than about 0.5 mils and less than about 4 mils.

- 2. The fabric laminate of claim 1 further sandwiching a woven moldable stretch fabric suitable for bubble molding a cup by application of sufficient heat and pressure in an identified area of the fabric laminate.
- 3. The fabric laminate of claim 2 wherein the woven stretch fabric material is synthetic fabric.
  - 4. The fabric laminate of claim 1 further including at least one cup.
- 5. The fabric laminate of claim 1 further having a plurality of edges wherein at least one edge from the plurality of edges has a laminated finish following a die-cutting operation, wherein furthermore, the laminated finish does not require additional finishing with the aid of sewing.
- 6. The fabric laminate of claim 5 wherein the at least one edge having a laminated finish is treated with a hot surface following the die-cutting operation to smooth out fraying fibers created by the die-cutting operation.

- 7. The fabric laminate of claim 4 further including a plurality of openings wherein at least one opening from the plurality of openings is suitable for placing therein at least one member of the set consisting of a human arm, a human shoulder, a human torso, a human thigh, a human neck, and a human leg.
  - 8. (Cancelled).
  - 9. (Cancelled).
- 10. The fabric laminate of claim 1 wherein the thickness of the adhesive layer is between about 0.5 mil and about 2.0 mil.
- 11. The fabric laminate of claim 10 wherein the thickness of the adhesive layer is between about 1.0 mil and about 1.5 mil.
- 12. The fabric laminate of claim 1 wherein the thickness of the adhesive layer is about 4.0 mil.
  - 13. (Cancelled).
- 14. (Original) The fabric laminate of claim 1 wherein the adhesive layer comprises ether-based polyurethane.
- 15. (Original) The fabric laminate of claim 14 wherein the adhesive layer comprises at least 50% ether-based polyurethane.
- 16. (Original) The fabric laminate of claim 15 wherein the adhesive layer comprises at least 90% ether-based polyurethane.
- 17. (Original) The fabric laminate of claim 16 wherein the adhesive layer comprises at least 99% ether-based polyurethane.
- 18. The fabric laminate of claim 1 wherein the adhesive layer comprises treated ester-based polyurethane with enhanced hydrolytic stability.

- 19. The fabric laminate of claim 1 wherein the adhesive layer comprises at least 50% ester-based polyurethane with enhanced hydrolytic stability.
- 20. The fabric laminate of claim 19 wherein the adhesive layer comprises at least 90% ester-based polyurethane with enhanced hydrolytic stability.
- 21. The fabric laminate of claim 20 wherein the adhesive layer comprises at least 99% ester-based polyurethane with enhanced hydrolytic stability.
- 22. The fabric laminate of claim 1 wherein the adhesive layer has a hydrolytic stability of at least 740 days.
- 23. The fabric laminate of claim 1 wherein the adhesive layer has a hydrolytic stability of at least 1000 days.
- 24. The fabric laminate of claim 1 wherein the adhesive layer has a hydrolytic stability of at least 5000 days.
- 25. The fabric laminate of claim 1 further including at least one insert held between the prelaminated first fabric and the second fabric by sandwiching the at least one insert between the first fabric and the second fabric followed by lamination of the first fabric to the second fabric.
- 26. The fabric laminate of claim 25 wherein the at least one insert is a wire shaped to provide support to at least one breast of a wearer of a garment.
- 27. A brassiere laminated together by application of heat and pressure on at least two fabric layers sandwiching an adhesive layer for providing support to at least one breast of a wearer, the brassier comprising:

the at least two fabric layers;

a third layer of woven, stretch fabric placed in an area suitable for bubble molding such that the third layer, having an adhesive layer prelaminated thereon, is sandwiched between the at least two fabric layers;

at least one cup formed by a bubble molding process such that the at least two fabric layers and the third layer in the area suitable for bubble molding are shaped into a cup

having a desired size; and

at least one unsewn edge finished by lamination only whereby eliminating look and feel of a sewn finish, wherein the adhesive layer is more than about 0.5 mils and less than about 4 mils.

- 28. The brassiere of claim 27 further having at least one strap cushioned by laminating a woven, stretch fabric between the at least two fabric layers in an area suitable for forming a strap.
- 29. The brassiere of claim 27 wherein the adhesive layer is applied to one of the at least two fabric layers in a prelaminating step at a temperature and pressure to make the adhesive layer tacky without melting followed by contacting another layer of the at least two fabric layers to the prelaminated layer and laminating at sufficient temperature and pressure to melt the adhesive into the fibers of the at least two fabric layers.
- 30. The brassier of claim 27 further including at least one wire in association with the at least one cup.
- 31. The brassiere of claim 27 wherein the at least one cup provides hanger appeal by substantially retaining its shape without requiring a filler or support material.
  - 32. (Cancelled).
- 33. The brassiere of claim 27 wherein the thickness of the adhesive layer is between about 0.5 mil and about 2.0 mil.
- 34. The brassiere of claim 33 wherein the thickness of the adhesive layer is between about 1.0 mil and about 1.5 mil.
- 35. The fabric laminate of claim 27 wherein the adhesive layer comprises ether-based polyurethane.
- 36. The brassiere of claim 35 wherein the adhesive layer comprises at least 50% ether-based polyurethane.

- 37. The brassiere of claim 35 wherein the adhesive layer comprises at least 90% ether-based polyurethane.
- 38. The brassiere of claim 36 wherein the adhesive layer comprises at least 99% ether-based polyurethane.
- 39. The brassiere of claim 27 wherein the adhesive layer comprises treated esterbased polyurethane with enhanced hydrolytic stability.
- 40. The brassiere of claim 39 wherein the adhesive layer comprises at least 50% ester-based polyurethane with enhanced hydrolytic stability.
- 41. The brassiere of claim 39 wherein the adhesive layer comprises at least 90% ester-based polyurethane with enhanced hydrolytic stability.
- 42. The brassiere of claim 39 wherein the adhesive layer comprises at least 99% ester-based polyurethane with enhanced hydrolytic stability.
- 43. The brassiere of claim 27 wherein the adhesive layer has a hydrolytic stability of at least 740 days.
- 44. The brassiere of claim 27 wherein the adhesive layer has a hydrolytic stability of at least 1000 days.
- 45. The brassiere of claim 27 wherein the adhesive layer has a hydrolytic stability of at least 5000 days.
  - 46. The brassier of claim 27 wherein the cup size is at least A and at the most D.
- 47. The brassiere of claim 46 further being part of a matched set of undergarments including at least one pair of panties.

#### EXHIBIT C EVIDENCE APPENDIX

## CLAIMS MARKED FOR EXAMINATION U.S. APPLICATION NO. 10/001,286 ATTORNEY DOCKET NO. 9971-005-999

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S. Patent and Trademark Office

Part of Pager No. 20040120

#### EXHIBIT D EVIDENCE APPENDIX

## <u>SELECTED DETAILS OF ACTUAL SEARCHES</u> <u>U.S. APPLICATION NO. 10/001,286</u> <u>ATTORNEY DOCKET NO. 9971-005-999</u>

L Number	Hits	Search Text	DB	Time stamp
•	6	(("5447462") or ("5967876") or	USPAT;	2004/10/20
		("5984762")).PN.	US-PGPUB;	16:22
			EPO; JPO;	
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-	1	10/001,286	USPAT;	2004/10/19
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•	11	(("4976706") or ("4627427") or ("5447462")	USPAT;	2004/10/29
		or ("4372321") or ("3383263")).PN.	US-PGPUB;	12:03
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-	48	(("2915067") or ("3021844") or ("3225768")	USPAT;	2004/10/29
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İ		or ("3383263") or ("3497415") or ("3750673")	EPO; JPO;	
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-	128	(bubble near2 molding)	USPAT;	2004/10/29
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•	16	(laminate) and ( (bubble near2 molding))	USPAT;	2004/10/20
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-	17	or ("4372321") or ("3383263")).PN.) or	US-PGPUB;	2004/10/20 :16:30
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ļ -	120	(bubble near2 molding)	USPAT;	2004/10/29
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-	1	(polyurethane or poly\$urethane) and	USPAT;	2004/10/29
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-	1375	((2/73) or (450/1,41) or (442/394)).CCLS.	USPAT;	2004/10/29
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<b>-</b>	44	((polyurethane or poly\$urethane) near4	USPAT:	2004/10/29
!		film)and (((2/73) or (450/1,41) or	US-PGPUB;	12:24
	1	(442/394)).CCLS.)	EPO; JPO;	
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<b>-</b>	11	("4143662"   "4557267"   "5447462"	USPAT	2004/10/29
i		"5553468"   "5660577"   "5916829"		12:11
		"6000994"   "6180178"   "6238266"		
		"6287168"   "6439959").PN.		{
-	5	g22.as. and altesse.as.	USPAT;	2004/10/29
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_	8	altesse.as.	USPAT:	2004/10/29
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-	2	("20020151239").PN.	USPAT;	2004/10/29
	1	,	US-PGPUB;	13:41
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	1 1		DERWENT	
-	3	( (bubble near2 molding) ) and fabric	USPAT;	2004/10/29
		<b>0, ,</b>	US-PGPUB;	14:53
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. •	138	seamless same (bra or brassiere)	USPAT;	2004/10/29
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•	6	(seamless same (bra or brassiere)) and	USPAT;	2004/10/29
	'	laminate	US-PGPUB;	14:57
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•	2	not\$sew near10 seamless	USPAT;	2004/10/29
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•	2	("4776911").PN.	USPAT;	2004/10/29
	1		US-PGPUB;	14:58
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			DERWENT	

•	2	("4776916").PN.	USPAT;	2004/10/29
1	1		US-PGPUB;	14:58
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<b>-</b>	17	(("4701964") or ("3228401") or ("3021844")	USPAT;	2004/10/29
}	1	or ("4172002") or ("4372321") or	US-PGPUB;	14:59
		("3317645")).PN.	EPO; JPO;	
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Search Notes	

Application No.	Applicant(s)	
10/001,286	AERTS, ERIC	
Examiner	Art Unit	
Christopher C Pratt	4774	

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Search Notes			

Application No.	Applicant(s)
10/001,286	AERTS, ERIC
Examiner	Art Unit
Christopher C Pratt	1771

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## EXHIBIT E EVIDENCE APPENDIX

# INVENTOR AFFIDAVIT SUBMITTED IN SEPTEMBER OF 2006 UNDER 37 §CFR 132 U.S. APPLICATION NO. 10/001,286 ATTORNEY DOCKET NO. 9971-005-999



IN THE UNITED SPATES PATENT AND TRADEMARK OFFICE

Application of: AERTS, Eric.

Confirmation No.:

2124

Serial No.:

10/001,286

Art Unit:

1771

Filed:

November 30, 2001

Examiner:

TORRES VELASQUEZ,

NORCIA LIZ

For:

**NOT-SEW SEAMLESS** 

Attorney Docket No:

9971-005-999

**TECHNOLOGY** 

(636744-999003)

#### **DECLARATION UNDER 37 C.F.R. §1.132 BY MR. ERIC AERTS**

Commissioner for Patents P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, ERIC T. AERTS, do solemnly and sincerely declare and state that:

#### I. Background

- 1. I am the inventor of the above-identified application and several patent and patent applications assigned to G22 Altesse ("G22"). I am the inventor in US Patent No. 6,132,288 ("the '288 patent"), for which an application was filed on May 11, 1999. I am also the inventor in US Patent Application No. 10/668,462 in addition to the above-captioned patent application. These patents and patent applications are collectively referred to herein as the 'G22 Patent Filings'.
  - 2. I live at 4 Jennifer Lane; Warren, NJ 07059.
- 3. I was employed by G22 Altesse, a company in the business of laminated undergarment technology for several years.
- 4. I helped to design and build much of the laminating machinery used in G22's factory.
- 5. I personally tested hundreds of different fabrics, adhesives, garment designs, temperatures, cycle times, pressure amounts, etc. in the development of G22's products.
- 6. I personally engaged in and oversaw the manufacturing of G22's laminated products

- 7. I understand that prelamination is presently not considered to be a limitation by the Patent Office in evaluating the claims directed to products in the above-referenced application, although the Patent Office may change its view.
- 8. I have read and am familiar with most of the prior art relating to the claimed invention.
- 9. I have read US Patent No. 3,657,060 ("the '060 patent") cited in the course of the prosecution of the above captioned patent application. The following remarks are provided in support of the patentability of the claimed invention.
- II. Adhesive in one physical form is not the same as another adhesive in a second physical form even if the two adhesives have the same thickness.
- 10. It is not proper to infer that an adhesive in the form of a film is equivalent to the same thickness of an adhesive in the form of powders, webs or liquids.
- 11. Powder, web or liquid form of the adhesive affects the physical properties of the entire laminated article.
- 12. The physical form of the adhesive has an influence on many properties of a laminated article such as porosity, strength of adhesion, peeling, edge finish, and the amount of adhesive required.

### III. G22 made machinery and laminated articles using polyurethane films having a thickness of less than 5 mils.

- 13. I could not find any teaching or suggestion for using prelamination in the '060 patent.
- 14. I determined that the '060 patent teaches lamination using a polyurethane film adhesive having a thickness greater than 5 mils.
- 15. Thick films are not a significant problem in the preparation of laminated articles.
- 16. In my experience, the thicker the adhesive film, the easier it is to handle the film.
- 17. Lamination with thick films yields articles with many less desirable properties.
- 18. In my experience, a strong bond is possible with thicker films, but thicker films also make the laminated fabric feel too rigid or rubbery.

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- 19. However, lamination using thin films, such as less than 5 mils thick, has been a problem.
- 20. I understand obviousness to mean finding all of the limitations of a claim in more than one reference source, with evidence of a motivation to combine by one having no more than the ordinary skill in the art.
- 21. I discovered that the use of prelamination allows the use of thinner films for effective lamination resulting in the consistent preparation of laminated articles with a soft feel not possible previously.
- 22. Under my direction, the prelamination process helped G22 use and handle thinner films and thus create a softer feeling laminated garment.
- 23. The thinner laminated garments prepared with the aid of the prelamination process for handling the thin adhesive film unexpectedly did not suffer from excessive peeling.
- 24. The thinner laminated garments prepared with the aid of the prelamination process for handling the thin adhesive film exhibited excellent fabric feel.
- 25. I believe, the above-captioned patent application is the first patent application filing that teaches the making of a laminated article with adhesive films thinner than 5 mils.
- 26. I believe, the above-captioned patent application is the first patent application filing that teaches the making of a laminated article with adhesive films thinner than 5 mils is unexpected and, as a result, non-obvious.
- 27. As is apparent from the clear teaching in the '060 patent, acceptable laminated articles made with adhesive films thinner than 5 mils are unexpected.
- 28. Under my direction, G22 routinely prepared laminated articles using 3-4 mil thick films.
- IV. G22 was the first manufacturer to utilize prelamination technology described in the above-captioned application to make a brassier with a large cup size.
- 29. In my experience, different types of laminated articles present different problems depending on the intended use of the article and the method of manufacturing.
- 30. In my experience, preparation of laminated straps is expected to present different technical issues than the molding of cups in a laminated brassier.

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- 31. In my experience, it is expected that when making a brassier, as larger cups are molded, the fabric, fibers, and adhesives become thinner and weaker due to stretching compared to smaller cups.
- 32. In my experience, it is expected that larger cups provide greater support due to the larger breast to be supported by them.
- 33. Under my direction, G22 was able to increase the cup size with the addition of spacer-fabric lining to overcome the prior art limitations.
- 34. The largest brassier cup-size that I produced and successfully fitted was a 40DD/42D.
- 35. Under my direction, G22 was the first manufacturer to successfully execute a 40DD/42D size brassiere made exclusively from a single, continuous lamination (i.e. one process) by providing the necessary support.
- 36. In the absence of the above-captioned patent application, the making of a brassier with large cup sizes using lamination is not only novel, but is also not obvious.
- 37. In conclusion, the '060 patent (i) establishes the need to use adhesive polyurethane films with thickness of more than 5 mils, (ii) does not teach, disclose or suggest making a brassier with a large cup size, and (iii) does not teach, disclose or suggest the use of prelamination.
- 38. Articles made using adhesive polyurethane films of greater than 5 mil thickness are less desirable due to their different physical properties than those made using adhesive films of less than 5 mils thickness as is taught in the above-captioned patent application.

L.S.

39. I declare further that all statements made herein of my own knowledge are true and that all statements made are believed to be true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal the day and year set opposite my signature.

Dated: 4/12/06

enci. Aeris.

Inventor, US Patent Application Nos. 10/001,286 and 10/668,462